

Remarks

Applicant appreciates the Examiner's acknowledgement that the finality of the previous Office Action was improper and the issuance of a new Office Action. As discussed below, the § 103(a) rejections cannot be maintained because the Examiner's proposed modification of the '617 reference would render the '617 reference unsatisfactory for its intended purpose.

The final Office Action dated December 10, 2008 listed the following rejections: claims 1-10, 12-14, 16 and 18 stand rejected under U.S.C. § 103(a) over Kilkki (U.S. Patent No. 6,411,617) in view of Hellwig (U.S. Patent No. 6,931,020); and claims 11, 15, 17 and 19 stand rejected under U.S.C. § 103(a) over Kilkki in view of Hellwig and further in view of Cisneros (U.S. Patent No. 5,157,654). Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant respectfully traverses the § 103(a) rejections of claims 1-19 because modifying the '617 reference such that ports 118 and 120 (*i.e.*, the asserted virtual ports) are subject to the same contention resolution process as ports 116, 117, 122, and 123 (*i.e.*, the asserted I/O ports) would render the '617 reference unsatisfactory for its intended purpose. *See e.g.*, M.P.E.P. § 2143.01 and *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) ("If (the) proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."). In this instance, a stated purpose of the '617 reference is to provide a network that recognizes SIMA (Simple Integrated Media Access) packets and that accounts for the quality of service principles provided by a SIMA service class within a conventional non-priority-based network such as an ATM network. *See, e.g.*, Col. 3:25-36. Specifically, the '617 reference teaches that network node congestion control is applied to the data packets at dedicated output port 118 to selectively accept or discard the data packets in accordance with pre-defined SIMA priority principles, whereas congestion control applied at the I/O ports (116, 117, 122 and 123) of conventional ATM switch 112 is non-priority-based. *See, e.g.*, Figure 8, Col. 3:14 to Col. 4:2, and Col. 12:52 to Col. 13:41. Applicant submits that modifying the '617 reference such that the ports (116, 117, 118, 120, 122 and 123) are subjected to a common non-priority-based contention resolution process would

render the network of the '617 reference unable to accommodate the priority principles of SIMA, thereby rendering the '617 reference unsatisfactory for its intended purpose. Applicant further submits that modifying the '617 reference such that the ports (116, 117, 118, 120, 122 and 123) are subjected to a common contention resolution process that accounts for the priority principles of SIMA would undermine the '617 reference's purpose of allowing a SIMA network to be integrated with a conventional unmodified ATM network switch. Therefore, there is no motivation for the skilled artisan to modify the '617 reference in the manner proposed by the Examiner.

Moreover, in the instant Office Action, the Examiner fails to adequately address Applicant's previous arguments regarding the impropriety of the proposed modification of the '617 reference. Instead of addressing the substance of Applicant's previous argument as required (*see, e.g.*, M.P.E.P. § 707.07(f)), the Examiner simply discusses contention resolution in regard to dedicated port 118. For example, the Examiner discusses portions of the '617 reference (*i.e.*, col. 6:33-36) relating to SIMA's use of a buffer "to manage discarding the packets and accepting certain priority level of packets." *See* page 2 of the Office Action. As such, the Examiner's response simply discusses the pre-defined SIMA priority principles that the '617 reference teaches are used to apply congestion control at dedicated output port 118. The Examiner, however, fails to address the proposed modification of the '617 reference, which would involve subjecting the dedicated port 118 and output ports 122 and 123 to the same contention resolution process (either priority or non-priority based). As such, the Examiner's discussion does not rebut Applicant's previous argument regarding the impropriety of modifying the '617 reference in this manner. As discussed above, such a modification would render the '617 reference unsatisfactory of its intended purpose. As stated in M.P.E.P. § 2143.01, because the asserted modification would undermine the purpose of main ('617) reference, not only is such a § 103 rejection improper but the references teach away from the proposed modification.

This principle has been embraced by the Supreme Court's recent *KSR* decision in connection with the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). The Court stated that, "when the prior art teaches away from combining certain known elements, discovery of a

successful means of combining them is more likely to be non-obvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). Among other improprieties discussed herein, the ‘617 reference teaches away from the proposed modification.

In view of the above, the § 103(a) rejections of claims 1-19 are improper and Applicant requests that they be withdrawn.

Applicant further traverses the § 103(a) rejections of claims 1-19 because the Examiner fails to provide a valid reason for the proposed modification of the ‘617 reference. Applicant submits that the asserted basis to combine is contrary to the requirements of § 103 and relevant law. *See, e.g., KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007) (“A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.”). In this instance, the Examiner asserts that the skilled artisan would modify the ‘617 reference “to include a single contention resolution process for physical and virtual ports of a switch”...“in order (to) ensure high speed transmission within a switch” as allegedly taught by the ‘020 reference. The cited portions of the ‘020 reference, however, do not teach that using a single contention resolution process ensures high speed transmission within a switch. Instead, the ‘020 reference teaches that it is the integration of the contention resolution unit CR into the switching unit 5 that “results in the advantage of very short, high speed transmission lines.” *See, e.g.,* Col. 5:63 to Col. 6:2. As such, the Examiner has not presented any evidence that the proposed modification of the ‘617 reference would “ensure high speed transmission within a switch.” Accordingly, Applicant submits that the Examiner’s alleged reasons to combine amount to no more than conclusory statements of generalized advantages and convenient assumptions about skilled artisans. Such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on subjective belief and unknown authority. *See, e.g.,* M.P.E.P. § 2142 (“rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). Therefore, the § 103(a) rejections of claims 1-19 are improper and Applicant requests that they be withdrawn.

Applicant further traverses the § 103(a) rejections of claims 1-19 because the Examiner fails to cite to any reference that teaches or suggests subjecting I/O ports and at least one virtual port to one contention resolution process common to the I/O ports and the at least one virtual port. The Examiner acknowledges that the '617 reference does not teach subjecting dedicated ports 118 and 120 (*i.e.*, the asserted virtual ports) to the same contention resolution process as ports 116, 117, 122, and 123 (*i.e.*, the asserted I/O ports). The Examiner then cites to portions of the '020 reference that teach a switch 5 having several ports (*see, e.g.*, Figure 5); however, the cited portions of the '020 reference do not teach that any of the ports of switch 5 are dedicated ports (as taught by the '617 reference), or that any of the ports of switch 5 are virtual ports as in the claimed invention (*see, e.g.*, Applicant's Figures 2a and 2b). As such, the Examiner fails to cite to any reference that teaches or suggests subjecting I/O ports and virtual ports to the same contention resolution process. Accordingly, the § 103(a) rejections of claims 1-19 are improper and Applicant requests that they be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections/objections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9068.

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